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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,305	11/08/2001	Bruno Borsoi	P21570	5187
7055	7590	06/30/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PHAM, HUONG Q	
			ART UNIT	PAPER NUMBER
			3764	
DATE MAILED: 06/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,305

Applicant(s)

BORSOI, BRUNO

Examiner

Huong Q. Pham

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005 and 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-23 and 25-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-23 and 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, since this application is eligible for continued examination under 37 CFR 1.114, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/28/2005 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what structure is the recited "envelope".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1- 4, 8-9, 13-14, 16-- 23, 25, 27- 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Dachgruber et al (6,360,454).

As for claims 1, 19 , Dachgruber et al shows every claimed feature of the claims including a rigid frame 24 (figures 1, 3), one bending zone with an abutment 100 or 98 . Note that the apertures 100 or the notches 98 have abutting surfaces (abutting surfaces are the side-edges of apertures 100 or of notches 98), and when the device 24 of Dachgruber et al is flexed at certain degree, the abutting surfaces or edges are capable of having the function to limit flexion to some degree. As for claim 2, note notches 98. As for claim 3, note column 4, lines 11-16. As for claim 13, note eyelets 90 in figure 7. As for claim 16, note column 4, lines 6-7. As for claims 17, 26, the bending zone of Dachgruber et al is narrower than the supports. As for claims 4, 20- 23, note notches 98 and inserts 102 . As for claim 27, note the shock absorbing elements 102. As for claims 28, note shock absorbing element 102 and pocket 45.

Claims 1- 2, 4- 9, 17, 19- 23, 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Rathmell (4,043, 059) .

Rathmell shows every claimed feature of the claims including a rigid frame (figure 1), one bending zone with an abutment 5 . As for claim 4, note the compressible material in figure 4 . As for claim 5, note supports 3, or supports 1, 2 in figure 1. As for claim 6, note the envelope 1, 2 (for enclosing the upper and lower ankle areas) , and the shock absorbing elements in figure 3, 4 . As for claim 7, note that the adjacent upper fins 5 form a pocket which is affixed to the envelope 2. As for claim 17, note that the supports 1, 2 are wider than the bending zone. As for claim 28, note pocket 4 formed between fins 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103 as being unpatentable over Dachgruber et al.

Note that the provision of a recess in a shell of a footwear for accommodating toes of a wearer is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Dachgruber et al with a recess for accommodating toes of a wearer.

Claims 29, 30- 39 are rejected under 35 U.S.C. 103 as being unpatentable over Rathmell (4,043, 059) in view of Dachgruber et al.

As for claims 29, 30, Rathmell teaches substantially every claimed feature of claim 30, except that Rathmell does not mention the angle of movement as recited. Dachgruber et al teaches that the footwear can be flexed up to an angle of 45 degrees (column 4, lines 6- 8) . In view of the teaching of Dachgruber et al , it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Rathmell such that the angle of movement is no greater than 45 degrees. As for claim 36, note the base 1,2 of Rathmell. As for claim 39, note pocket 4 formed by fins 5 of Rathmell.

Claims 30, 40 are rejected under 35 U.S.C. 102(b) as being unpatentable over Filice (6,381, 8770) in view of Dachgruber et al.

Filice teaches substantially claimed feature of claim 30 except for the recited angle of movement. Dachgruber et al teaches that the footwear can be flexed up to an angle of 45 degrees (column 4, lines 6- 8) . In view of the teaching of Dachgruber et al , it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of Filice such that the angle of movement is no greater than 45 degrees. As for claim 40, Dachgruber et al teaches additional frame 24 fixed to tongue 22 for adjusting the stiffness of the ankle area. In view of the teaching of Dachgruber et al, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify the device of Filice by fixing the frame 22,24,26 of Filice to a tongue of any boot in order to adjust or control the stiffness of the ankle area.

Claims 1 is objected to because "said rigidity" lacks proper antecedent basis.

Applicant's arguments filed on 3/28/2005 have been fully considered but they are not persuasive. Applicant argues that "grooves 98 act to promote flexion", and "no written disclosure in Dachgruber that such apertures are abutments against flexing or bending". The examiner disagrees. Note the comments relative to the claims above for the teaching of Dachgruber (note abutment 100, 102, or 98 of Dachgruber et al). Note that the edges of the apertures 100, or the edges of the notches 98 have abutting surfaces, and when the device 24 of Dachgruber et al is allowed to flex at certain degree, the edges of the apertures or notches are abuted and therefore are capable of having the function of limiting or resisting flexion to some degree (note that in claim 1, the range of bending or angle is not recited).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272 - 4887. The fax phone

Art Unit: 3764

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2005

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN
PRIMARY EXAMINER